



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,977	02/23/2004	David S. Miller	31921-192598	2614

26694 7590 04/03/2007  
VENABLE LLP  
P.O. BOX 34385  
WASHINGTON, DC 20043-9998

EXAMINER
----------

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
----------	--------------

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 10/782,977  
Filing Date: February 23, 2004  
Appellant(s): MILLER, DAVID S.

**APR 03 2007**

**GROUP 3600**

Michael A. Sartori, Ph. D. (Reg. No. 41,289) and Ryan M. Flandro (Reg. No. 58,094)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 22, 2007 appealing from the Office action mailed December 22, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Reexam Application No. 90/006,713

Reexam Application No. 90/006,969

Application No. 10/978,430

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Art Unit: 3694

Beamer, Scott. "A Marriage of Convenience." MacUser, vol. 3, no. 3, page 102(4), March 1987.

"It's W-2 Time -- But This Year There's a Better Way to Do Your Taxes." PR Newswire, February 9, 1987.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21, 22, 24, 29, 30, 32, 37, 38, 40, 45, 46, 48, 53, 54, 56, 61, 62, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further supported by the disclosure of the article, "It's W-2 Time." In accordance with MPEP 2131.01, "It's W-2 Time" is cited as part of the rejection under § 102 to show various characteristics of MacInTax that are deemed to be inherent to the version of MacInTax described in Beamer. Beamer was published in March 1987 while "It's W-2 Time" was published on February 9, 1987 (within one month of each other and, incidentally, during

Art Unit: 3694

the traditional tax season in the United States), thereby further supporting the Examiner's assertion that Beamer and "It's W-2 Time" describe features of the same version of MacInTax.

Claims 23, 25-28, 31, 33-36, 39, 41-44, 47, 49-52, 55, 57-60, 63, and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further supported by the disclosure of the article, "It's W-2 Time", as applied to claims 21, 24, 29, 32, 37, 40, 45, 48, 53, 56, 61, and 64 above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 21, 29, 37, 45, 53, and 61 recite the step of electronically collecting tax data from a tax data provider. It is not clear how this electronic collection of data is performed. Claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66 limit the recited tax data to "tax data correspond[ing] to at least one item of tax liability reported

Art Unit: 3694

on at least one of Internal Revenue Service ('IRS') form, a state form, a local form, and a foreign tax form," "wherein said IRS form comprises one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, and an IRS Form 1099." It is not clear whether this limitation is meant to be a positive recitation of actively reporting data on an Internal Revenue Service ("IRS"), state, local, or foreign tax form or whether the limitation provides a mere clarification of the tax data as being the type of data that one would typically find reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form. In other words, do the claims require that the tax data expressly be reported and, if so, to whom? If Applicant submits that the intended scope of these claims necessitates an active reporting of the tax data on one of the recited forms, what is the extent of the data reported? In other words, does Applicant's invention report the actual image data or an OCR version of the contents of an entire W-2, 1098, or 1099 form or merely any data that would typically be found on each of the respective forms and used for tax reporting purposes? Once the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic return know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return? The specification provides limited explanation beyond the fact that W-2, 1098, and 1099-related data may be downloaded to automatically prepare an electronic tax return. Based on the disclosure in the specification, the Examiner interprets the claim scope as embodying any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of

Art Unit: 3694

each respective form), to prepare a tax return. If Applicant asserts a different interpretation, then proper support from the specification should be provided.

Also ambiguous is the intended scope of the phrase "tax data correspond[ing] to..." recited in claims 24, 32, 40, 48, 56, and 64. Does the word "corresponding" imply that the tax data is expressly limited to data values printed directly on one of the various recited tax forms or merely that the tax data is somehow related to other information that is printed on one of the various recited tax forms? This is especially confusing because the specification never mentions these particular types of forms or even that data reported on IRS, state, local, and foreign tax forms *per se* is expressly used as part of the intended invention. Pages 9-10 and 13 of the specification provide various examples of tax data providers (including employers, banks, mortgage institutions, and federal, state, local, and foreign taxing authorities) and various examples of tax data (including a payroll statement, bank statement, mortgage statement, and charity statement); however, neither excerpt addresses the details of specific tax forms from which tax data is directly garnered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 21, 29, 37, 45, 53, and 61 recite the step of electronically collecting tax data from a tax data provider. It is not clear how this electronic collection of data is performed. Claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66 limit the recited tax data to "tax data correspond[ing] to at least one item of tax liability reported on at least one of Internal Revenue Service ('IRS') form, a state form, a local form, and a foreign tax form," "wherein said IRS form comprises one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, and an IRS Form 1099." It is not clear whether this limitation is meant to be a positive recitation of actively reporting data on an Internal Revenue Service ("IRS"), state, local, or foreign tax form or whether the limitation provides a mere clarification of the tax data as being the type of data that one would typically find reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form. In other words, do the claims require that the tax data expressly be reported and, if so, to whom? If Applicant submits that the intended scope of these claims necessitates an active reporting of the tax data on one of the recited forms, what is the extent of the data reported? In other words, does Applicant's invention report the actual image data or an OCR version of the contents of an entire W-2, 1098, or 1099 form or merely any data that would typically be found on each of the respective forms and used for tax reporting purposes? Once the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic return know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return? The specification provides limited explanation beyond the fact that W-2, 1098, and 1099-related data may be downloaded to



automatically prepare an electronic tax return. Based on the disclosure in the specification, the Examiner interprets the claim scope as embodying any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of each respective form), to prepare a tax return. If Applicant asserts a different interpretation, then proper support from the specification should be provided.

Also ambiguous is the intended scope of the phrase "tax data correspond[ing] to..." recited in claims 24, 32, 40, 48, 56, and 64. Does the word "corresponding" imply that the tax data is expressly limited to data values printed directly on one of the various recited tax forms or merely that the tax data is somehow related to other information that is printed on one of the various recited tax forms? This is especially confusing because the specification never mentions these particular types of forms or even that data reported on IRS, state, local, and foreign tax forms *per se* is expressly used as part of the intended invention. Pages 9-10 and 13 of the specification provide various examples of tax data providers (including employers, banks, mortgage institutions, and federal, state, local, and foreign taxing authorities) and various examples of tax data (including a payroll statement, bank statement, mortgage statement, and charity statement); however, neither excerpt addresses the details of specific tax forms from which tax data is directly garnered.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 24, 29, 30, 32, 37, 38, 40, 45, 46, 48, 53, 54, 56, 61, 62, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further supported by the disclosure of the article, "It's W-2 Time." In accordance with MPEP 2131.01, "It's W-2 Time" is cited as part of the rejection under § 102 to show various characteristics of MacInTax that are deemed to be inherent to the version of MacInTax described in Beamer. Beamer was published in March 1987 while "It's W-2 Time" was published on February 9, 1987 (within one month of each other and, incidentally, during the traditional tax season in the United States), thereby further supporting the Examiner's assertion that Beamer and "It's W-2 Time" describe features of the same version of MacInTax.

The integration of MacInTax with Dollars & Sense discloses a computer-readable medium embodying a computer program for automatic tax data collection by an electronic intermediary, said computer program comprising code segments for:

[Claim 21] connecting electronically said electronic intermediary to a tax data provider (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g.,

Art Unit: 3694

MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense);

collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return);

processing electronically said tax data collected electronically from said tax data provider to obtain processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (¶¶ 3, 11)); and

preparing electronically an electronic tax return using said processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used

Art Unit: 3694

to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (¶¶ 3, 11));

[Claim 22] wherein said taxpayer specific tax data comprises taxpayer specific data related to tax liability (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26);

[Claim 24] wherein said taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state form, a local form, and a foreign tax form (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Completion of an IRS tax form is expressly disclosed by Beamer; therefore, by using data downloaded from a bank to complete the IRS tax form, said data qualifies as at the very least "tax data corresponding to data reported on an Internal Revenue Service ("IRS") tax form").

[Claims 29, 30, 32] Claims 29, 30, and 32 recite limitations already addressed by the rejection of claims 21, 22, and 24 above; therefore, the same rejection applies.

Art Unit: 3694

[Claims 37, 38, 40] Claims 37, 38, and 40 recite limitations already addressed by the rejection of claims 21, 22, and 24 above; therefore, the same rejection applies.

The integration of MacInTax with Dollars & Sense discloses a computer-readable medium embodying a computer program for automatic tax data collection by an electronic intermediary, said computer program comprising code segments for:

[Claim 45] connecting electronically a tax data provider to said electronic intermediary (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense); and

providing electronically tax data from said tax data provider to said electronic intermediary, wherein said tax data is taxpayer specific tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return);

wherein said electronic intermediary processes electronically said tax data collected electronically from said tax data provider to obtain processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to

Art Unit: 3694

perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (§§ 3, 11)); and

wherein said electronic intermediary prepares electronically an electronic tax return using said processed tax data (Beamer: §§ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (§§ 3, 11));

[Claim 46] wherein said taxpayer specific tax data comprises taxpayer specific data related to tax liability (Beamer: §§ 3, 4, 6, 15, 16, 23, 26);

[Claim 48] wherein said taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state form, a local form, and a foreign tax form (Beamer: §§ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download

Art Unit: 3694

relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Completion of an IRS tax form is expressly disclosed by Beamer; therefore, by using data downloaded from a bank to complete the IRS tax form, said data qualifies as at the very least "tax data corresponding to data reported on an Internal Revenue Service ("IRS") tax form").

[Claims 53, 54, 56] Claims 53, 54, and 56 recite limitations already addressed by the rejection of claims 45, 46, and 48 above; therefore, the same rejection applies.

[Claims 61, 62, 64] Claims 61, 62, and 64 recite limitations already addressed by the rejection of claims 45, 46, and 48 above; therefore, the same rejection applies.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25-28, 31, 33-36, 39, 41-44, 47, 49-52, 55, 57-60, 63, and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further supported by the disclosure of the article, "It's W-2 Time", as applied to claims 21, 24, 29, 32, 37, 40, 45, 48, 53, 56, 61, and 64 above.

Art Unit: 3694

[Claims 23, 25, 26] Beamer teaches the download of bank account-related tax data from a bank for use in electronically preparing and filing a tax return (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26). Beamer does not expressly teach that the bank account-related tax data is downloaded as data corresponding to an IRS Form 1099 *per se*; however, Official Notice is taken that it is old and well-known in the art of United States tax returns that the IRS Form 1099 summarizes information from a bank that a taxpayer needs to complete his/her tax return(s). For example, one version of the IRS Form 1099 includes data such as taxable interest earned on a bank account, i.e., information typically found on a bank statement. Beamer does not expressly teach that the downloaded tax data is expressly printed on an IRS Form 1040, 1040EZ, W-2, 1098, or 1099; however, Beamer clearly lays the groundwork for electronically downloading tax-related data, such as bank statement data (i.e., data that is typically listed on an IRS Form 1099), and then using this data for automatically and electronically performing the calculations necessary to file an electronic tax return. The Examiner asserts that it is extremely old and well-known in the art of tax filing that, similar to the IRS Form 1099, the IRS Forms 1040, 1040EZ, W-2, and 1098 also contain information that is necessary for many taxpayers in the United States to completely fill out their tax returns. Since Beamer's disclosure describes software that aims to automate much of the tax data collection and tax return preparation and filing process, the Examiner asserts that one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify the software disclosed by Beamer to download data gleaned directly from a taxpayer's IRS Forms 1040, 1040EZ, W-2 (which includes income and



Art Unit: 3694

wages data), 1098, and/or 1099 (which includes interest data) in order to more quickly and efficiently enable a taxpayer to automate the entire tax data collection and tax return preparation and filing process, especially since the taxpayer may already do so with bank statements, thereby reaping the benefits disclosed in Beamer.

[Claims 27, 28] As per claims 27 and 28, Beamer teaches means for connecting electronically an electronic intermediary to a tax data provider using an electronic link and means for collecting electronically tax data from said tax data provider using an electronic link, wherein the electronic link is an electronic data network (¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense). Beamer does not expressly teach that this electronic data network is the Internet nor that tax data is collected via electronic mail; however, Official Notice is taken that it was old and well-known in the art of communications at the time of Applicant's invention to utilize the Internet and electronic mail for remote electronic data communications. The Internet and electronic mail both facilitate quick, efficient, and relatively inexpensive communications among remotely (even globally) located entities. Since Beamer's bank from which a taxpayer electronically downloads tax-related bank statement information is likely located remotely from the taxpayer, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Beamer to perform its downloads of bank statements via the Internet and/or electronic mail in order to facilitate quick, efficient,

Art Unit: 3694

and relatively inexpensive communications among banks and taxpayers who are remotely (even globally) located.

[Claims 31, 33-36] Claims 31 and 33-36 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 39, 41-44] Claims 39 and 41-44 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 47, 49-52] Claims 47 and 49-52 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 55, 57-60] Claims 55 and 57-60 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 63, 65-68] Claims 63 and 65-68 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

#### **(10) Response to Argument**

In reference to the rejection under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, Appellant cites an excerpt from the specification to support the claimed step of “electronically collecting tax data from a tax data provider.” (Pages 13-14 of the Appeal Brief) The Examiner understands that the specification provides support for the electronic transmission of data; however, much of Appellant’s disagreement with the art rejection lies in the assertion that the prior art involves some form of manual intervention to facilitate the electronic transmission. Therefore, the Examiner has raised questions about the intended scope of Appellant’s disclosed and claimed invention. For example, does

Art Unit: 3694

Appellant's invention report the actual image data or an OCR version of the contents of an entire W-2, 1098, or 1099 form or merely any data that would typically be found on each of the respective forms and used for tax reporting purposes? Once the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic return know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return? Appellant responds to these questions by citing support for the related claim limitations from the specification and broadly asserting that "a person skilled in the art would, in fact, recognize in the instant specification a description of the invention defined by claims..." (Pages 16-20 of the Appeal Brief) Appellant, however, fails to provide sufficient evidence to establish that one skilled in the art **at the time of Appellant's invention** would have been able to glean enough information from Appellant's original disclosure to make and use the claimed invention. Appellant's original disclosure is so conceptual and lacks essential elements that it is not clear that Appellant had full possession of the knowledge of how to implement the claimed invention. As a matter of fact, many of Appellant's arguments seem to rely on more current knowledge generally available to skilled artisans as opposed to the level of knowledge generally available on or before May 8, 1997 (the earliest effective priority date of the instant application). This issue becomes more salient in Appellant's arguments regarding the art rejection. Appellant cannot have it both ways and argue that the prior art fails to address the intended level of automation (as claimed) without Appellant's original disclosure explaining in detail how Appellant's intended scope of automation is distinct from prior art versions of

automation. Consequently, the questions posed to Appellant in the § 112, 1<sup>st</sup> paragraph rejections should be capable of receiving complete and thorough responses based on the original disclosure, regardless of whether or not Appellant chooses to expressly recite such details in the claims themselves. Appellant has yet to cite portions of the specification that fill in the gaps required by skilled artisans at the time of Appellant's invention to confidently (and without substantial guesswork) make and use the claimed invention, as intended (and argued) by Appellant; therefore, the rejections under § 112, 1<sup>st</sup> paragraph are maintained.

Additionally, Appellant argues that support for the limitation "wherein said taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state form, a local form, and a foreign tax form" (claim 24) is found on page 4, lines 14-19 (page 16 of the Appeal Brief). It should be noted that page 4, lines 14-19 of the specification are part of the background of the invention; therefore, it is not clear that the background information was meant to be incorporated into Appellant's intended invention at the time of Appellant's earliest effective filing date. Furthermore, Appellant's cited excerpt specifically references IRS Forms W-2, IRS Forms 1099, and IRS Forms 1098. The scope of claim 24 is broader than that disclosed in the cited excerpt and it is not clear that Appellant had possession of such expanded breadth of the invention at the time of the earliest effective filing date nor are the limitations of claim 24 undeniably inherent to Appellant's original disclosure.

The Appellant disagrees with the Examiner's interpretation of the claim scope as embodying any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of each respective form), to prepare a tax return (page 19 of the Appeal Brief). Appellant also argues that the corresponding structure from the specification should be read into the claims written in means-plus-function format. However, the Examiner's rejections and responses to Appellant's arguments have reiterated that Appellant's intended scope of the invention is ambiguous. Appellant continues to argue that the prior art does not automate the recited steps of the claimed invention; however, the Examiner has had difficulty ascertaining the level of automation envisioned by the Appellant at the time of the earliest effective filing date. Automation of a method does not inherently preclude any human intervention. The specification and claim language are so vague that the Examiner cannot assess the true metes and bounds of the invention because the Appellant has not pointed out clear-cut claim language that is supported by the original disclosure and fully explains the intended level of automation. Merely using a computer to transmit data is an automatic form of transmitting data. Barring a specific teaching of the prevention of human intervention as part of the transmission process, a human is not precluded from interacting with or somehow facilitating the transmission. Appellant's arguments have seemed to assert the contrary. The Appellant has continuously argued what the invention *is not*, yet the Appellant has yet to fully explain what the invention *is*, as supported by the specification. Consequently, the Examiner has looked toward both the claim language

Art Unit: 3694

and the specification for clarification. Due to the vague and indefinite nature of the claims, appropriate rejections have been applied under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. Since the specification has failed to provide clarification for the ambiguities in the claims, corresponding rejections have been applied under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as well.

Appellant argues that, since manual input and communication of data among multiple software modules are required in Beamer to ultimately file a tax return, Beamer does not disclose the electronic and automatic receipt of tax data and preparation of a tax return thereof (pages 21-41 of the Appeal Brief). The Examiner respectfully disagrees. In paragraphs 3, 4, 6, 15, 16, 23, and 26, Beamer describes how the tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return ("It's W-2 Time" explains the capabilities of MacInTax in more detail, thereby further supporting this assertion). Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human. Both Appellant's specification as well as the claimed invention lack specific details to preclude the electronic and automatic receipt of tax data and preparation of a tax return thereof from involving any sort of manual input or

Art Unit: 3694

communication of data among various software modules; therefore, this argument is non-persuasive.

The Examiner would also like to emphasize that the most relevant excerpt from Appellant's specification explains the extent of human intervention as follows:

In FIG. 2, the electronic links **32-37** can be provided in a number of ways. ***Non-limiting examples of electronic links used to connect electronically the electronic intermediary and the tax data providers include:*** a general purpose computer electronically connected to telephone communication equipment using, for example, a modem or to an electronic data network, such as the Internet; or a ***computer-readable medium for transferring and receiving the tax data.***

Non-limiting examples of the tax data electronically collected from the tax data providers include the following: a payroll statement, ***a bank statement***, a savings and loan statement, a mortgage statement, a credit card bureau statement, a thrift institution statement, a brokerage account statement, a mutual fund statement, or a charity statement...

Hence, with the electronic collection of tax data as in step **12**, the invention ***eliminates the current requirement that a taxpayer manually collect the tax data, eliminates the current requirement that a taxpayer manually enter such tax data onto a tax return or into a computer, and eliminates the need for all, or virtually all, intermediate hard copies of tax data, thereby saving paper, time, and cost.***

In step **13**, the electronic intermediary processes the tax data obtained electronically from the tax data providers in step **12**. In the present invention, ***step 13 can be implemented using a computer program similar to the computer programs currently available in the market place, such as TurboTax, which is a registered trademark of Intuit, Inc.*** Although step **13** can be implemented with current technology, the current technology requires that the tax data and other information relevant to the taxpayer be inputted manually. With the present invention, this information is obtained as described above in steps **11** and **12**. (*Emphasis added, Page 12, line 17 through page 14, line 12 of the specification*)

There is no mention of the instant invention being limited to a single software module. As a matter of fact, the non-limiting examples of an electronic link include “a computer-readable medium for transferring and receiving the tax data.” This is merely a floppy disk or CD containing the tax data, which also raises the question of whether or not a human can intervene at all in the collection of tax data. Furthermore, the instant invention is described as being implementing using existing software, such as TurboTax® (which is a software product of Intuit, Inc.). The demarcation between one off-the-shelf software program being integrated into another piece of software that performs the alleged novel steps of the instant invention is not made clear by the specification. The extent of true automation is equally unclear. By eliminating “the current requirement that a taxpayer manually collect the tax data,...the current requirement that a taxpayer manually enter such tax data onto a tax return or into a computer, and...the need for all, or virtually all, intermediate hard copies of tax data” (page 13, lines 14-17 of the specification), does this imply that the human does not even need to press a button requesting that tax data be downloaded? Or can the human indicate (e.g., via selection of a data source using a mouse) from where to collect data and then press “go” to initiate data transfer? What is the extent of “automatic”? This question is especially interesting in light of the use of off-the-shelf software (such as TurboTax®), which admittedly requires some form of manual input. The specification does not render a clear picture of the intended metes and bounds of any claim details relating to the automatic collecting and processing of tax data. Clearly, Beamer discloses that the tax preparation software, e.g., MacInTax, can electronically connect



Art Unit: 3694

to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense (¶¶ 3, 4, 6, 15, 16, 23, 26). This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (¶¶ 3, 11), i.e., automatically and electronically.

Appellant argues, "In contrast to claims 1 and 12 in *MercExchange*, the instant claims do not recite any steps or contain any elements that require manual intervention by the taxpayer, or any other human user or participant. Therefore, following the Federal Circuit's reasoning in *MercExchange*, each and every one of the various steps and elements in at least claims 21, 29, 37, 45, 53, and 61 must be construed as being conducted automatically." (Page 33 of the Appeal Brief) The claimed invention does not preclude prior art that involves some manual intervention. As explained above and in the art rejection, Beamer teaches the use of a computer and software to **automatically** and **electronically** perform the recited functionality in at least claims 21, 29, 37, 45, 53, and 61. Contrary to Appellant's assertions on pages 33-36 of the Appeal Brief, the Examiner submits that the art rejection does grant weight to all claimed recitations of the words "automatic(ally)" and "electronically"; therefore, Appellant's arguments are non-persuasive. This and the aforementioned discussions regarding Beamer's disclosure of

Art Unit: 3694

automatically and electronically performing recited functionality also address Appellant's arguments presented on pages 41-44 of the Appeal Brief).

Appellant argues that Beamer's collected data is not the same as the recited tax data (pages 38-41 of the Appeal Brief). The Examiner respectfully disagrees. Beamer discloses that the tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense (¶¶ 3, 4, 6, 15, 16, 23, 26). This downloaded information is used to assist in completing one's tax return. Completion of an IRS tax form is expressly disclosed by Beamer; therefore, by using data downloaded from a bank to complete the IRS tax form, said data qualifies as tax data since it provides information that is required to complete one's tax return. Beamer ultimately utilizes the downloaded bank statement information to electronically prepare a tax return, thereby addressing both the spirit and literal interpretation of the claimed invention.

Furthermore, Appellant's independent claims recite "collecting electronically tax data from said tax data provider." Since the collected tax data is not referred to as "said tax data," it is not necessarily required that the collected tax data be the type of tax data expressly recited as possessed by the tax data provider.

Appellant's arguments regarding the art rejection under § 103(a) reiterate Appellant's arguments presented in reference to the art rejection under § 102; therefore, the Examiner's response to these § 102 arguments is applicable to Appellant's § 103(a) arguments as well.

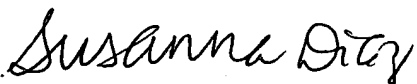
#### **(11) Related Proceeding(s) Appendix**

Art Unit: 3694

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Susanna M. Diaz  
Primary Examiner  
Art Unit 3694

Conferees:



James Trammell  
Supervisory Patent Examiner  
Art Unit 3694



Robert Weinhardt  
Business Practice Specialist  
Technology Center 3600